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**THIS DISPOSITION
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Paper No. 9
RFC

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Applied Molecular Evolution, Inc.

Serial No. 75/910,733

James J. Wong of Campbell & Flores LLP for Applied
Molecular Evolution, Inc.

James T. Griffin, Trademark Examining Attorney, Law Office
103 (Michael Hamilton, Managing Attorney).

Before Cissel, Wendel and Bottorff, Administrative
Trademark Judges.

Opinion by Cissel, Administrative Trademark Judge:

On February 2, 2000, applicant filed the above-identified application to register the mark "CODON BASED SYNTHESIS" on the Principal Register for "research activities directed toward the molecular engineering of compounds for use in therapeutics, diagnostics, agricultural products, enzymes, chemical products, nutritional products, food additives and industrial applications, including but not limited to, commodity and

specialty chemicals," in Class 42. The basis for filing the application was applicant's assertion that it possessed a bona fide intention to use the mark in commerce in connection with these services.

The Examining Attorney refused registration under Section 2(e)(1) of the Lanham Act, 15 U.S.C. Section 1052(e)(1), on the ground that the mark applicant seeks to register is merely descriptive in connection with the services recited in the application. The refusal to register was based on his conclusion that the mark identifies a feature or characteristic of the services, in that it "describes a particular type of synthesis, and the applicant's molecular engineering research presumably focuses on this area." Attached to the refusal to register were dictionary definitions of "codon" as "a sequence of three adjacent nucleotides constituting the genetic code that specifies the insertion of an amino acid in a specific structural position in a polypeptide chain during protein synthesis"; and of "synthesis" as the "formation of a compound from simpler compounds or elements."

Applicant responded to the refusal to register by arguing that the term it seeks to register is not merely descriptive of the services set forth in the application. Applicant conceded that "applicant's mark 'CODON BASED

SYNTHESIS' describes a method of peptide and protein synthesis, where nucleic acids [are] grouped in sets of three, that is, 'codons' [sic] acts as a template for peptide/protein synthesis." Applicant further admitted that it "may use protein synthesis during the course of its molecular engineering activities." Notwithstanding these concessions, applicant argued that its services are not "synthesis" services, but rather are molecular engineering research services, so that the mark it seeks to register is only suggestive in connection with applicant's services.

The test for determining whether mark is merely descriptive is well settled. A mark is merely descriptive under Section 2(e)(1) of the Lanham Act if it immediately and forthwith conveys information concerning a significant quality, characteristic, feature, function, purpose or use of the goods or services with which it is used or is intended to be used. In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987); In Re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215 (CCPA 1978). It is not necessary that a term describe all the properties, features or characteristics of the goods or services in order for it to be considered to be merely descriptive of them; rather, it is sufficient the term describes any significant attribute or idea about them. Whether a term is merely descriptive

is determined not in the abstract, but rather in relation to the goods or services for which registration is sought, the context in which it is being used (or is intended to be used) in connection with those goods or services and the possible significance that it would have to the average purchaser of the goods or services because of the manner of its use. See: *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979). A mark is suggestive, rather than merely descriptive, if, when the goods or services are encountered under the mark, a multi-stage reasoning process, or the use of imagination, thought or perception is required in order to determine what particular attributes of the goods or services the mark indicates. *In re Mayer-Beaton Corp.*, 223 USPQ 1347 (TTAB 1984). The Examining Attorney bears the burden of establishing that mark is unregistrable because it is merely descriptive of the goods or services within the meaning of Section 2(e)(1). *In re Gyulay*, supra.

When these principles are applied to the facts of the case at hand, we find that applicant's mark is merely descriptive of the services specified in the application because it describes a feature or characteristic of them, namely that applicant's research activities include codon based synthesis. As noted above, applicant has conceded that the term describes a method of protein synthesis and

that applicant may use protein synthesis during the course of its molecular engineering activities. This is clearly what the term applicant seeks to register would connote if it were to be used in connection with conducting research into the molecular engineering of compounds for use in the variety of applications listed in the application.

Applicant's argument to the contrary is not persuasive. As noted above, applicant contends that the mark is not descriptive of its services because applicant does not provide "synthesis services, themselves," but rather services which are "directed to the molecular engineering of compounds for use in various types of products." As the Examining Attorney points out, however in that applicant has conceded it may use codon based synthesis during the course of its molecular engineering activities, the mark is merely descriptive of this fact, so it is descriptive of a feature or characteristic of those activities.

It is not necessary for term to describe all of the purposes, functions, features or characteristics of the services in order for it to be merely descriptive of them. It is enough if the term describes one significant attribute of the services. In re H.U.D.D.L.E., 216 USPQ 538 (TTAB 1982); In re MBAssociates, 180 USPQ 338 (TTAB

1973). Applicant has not even attempted to explain what non-descriptive significance the term it seeks to register would have in connection with the services recited in the application. No multi-stage reasoning or complex thought processes are needed in order to understand from consideration of this term in connection with the specified services that the services entail research involving codon based synthesis. Because the mark identifies this feature, characteristic or attribute of the services, the term is unregistrable under Section 2(e)(1) of the Lanham Act.

DECISION: The refusal to register is affirmed.